



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,275	10/22/2008	Steffan Gottfried Klein	P-9035-US	5419
49443 7590 08/10/2010 Pearl Cohen Zedek Latzer, LLP 1500 Broadway 12th Floor New York, NY 10036				
EXAMINER				
RAVETTI, DANTE				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
08/10/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/588,275

Applicant(s)

KLEIN, STEFFAN GOTTFRIED

Examiner

DANTE RAVETTI

Art Unit

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
4a) Of the above claim(s) 1-39 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 40-59 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 22 October 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This communication is in response to the original Application No. 10/588,275 filed on 22 October 2008.
2. Claims 40-59 are currently pending and have been fully examined.
3. Claims 1-39 have been cancelled by the Applicant.
4. For the purpose of applying the prior art, PreGrant Publications will be referred to using a four digit number within square brackets, e.g. [0001].

Examiner's Comments/Remarks

5. Clauses (e.g. whereby, thereby, wherein) that merely states the result of the limitation(s) of a claim(s) does not limit the scope of the claim(s).¹ Therefore, what the indication comprises, as recited in claim 41, will not limit the scope of the claim.

Examiner would like to point out that the language of claim 41, and in others, describes, "non-functional descriptive material." For example, as to claim 41, Applicant recites, "wherein the indication...is valid....is invalid." However, this is an example of non-functional descriptive material.¹

Claim 46 contains similar language found in claim 41.

In light of Applicants' choice to pursue method claims, Applicants are also reminded that functional recitations using the word "for," "configured to," or other

¹ In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II; Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate;

functional terms² (e.g. see claim 48, which recites, "...means for ...") have been considered but are not given patentable weight³ because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered; however, a recitation of the intended use in a method claim must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation.⁴ Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Claims 49-51 contains similar language found in claim 48.

Examiner would like to point out that the language of claim 59, and in others, describes, "non-functional descriptive material." For example, as to claim 59, Applicant recites, "computer instruction code embodied on said computer...." However, Applicant seems to be missing the proper Beauregard language "...when executed, causes the computer/processor to perform...." Therefore, is an example of non-functional descriptive material.⁵

² MPEP §2106 II C;

³ In re Gulack, 703 F. 2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983)(stating that although all limitations must be considered, not all limitations are entitled to patentable weight);

⁴ In re Casey, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself."); In re Otto, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115.

⁵ In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II; Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 46, 50, 53 and 57 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 46 recites the limitation "the step of transmitting" in 46. There is insufficient antecedent basis for this limitation in the claim. It is unclear, which "transmitting step" the Applicant is referring to. (e.g. transmitting the electronic order to the validation server, or transmitting the electronic order to at least one relevant merchant or transmitting the report to one....) Therefore, the scope of the claim is not clear. One of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 50, 53 and 57 contains similar language or like deficiencies found in claim 46.

.... [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate;

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 40-43, 48, 52, 55 and 59 are rejected under 35 U.S.C. §102(e) as being anticipated by Hughes et al., (US 2008/0255982) ("Hughes").

As to claims 40, 48, 52, 55 and 59:

Hughes expressly teaches:

transmitting an electronic order of the customer over the public data network from the customer computer to a validation server that validates order critical data included in the order ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

the validation server executing the steps of: verifying said order critical data ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7); and

generating an indication of the validity or otherwise of the order critical data ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

As to claim 41:

Hughes expressly teaches:

wherein the indication of whether the order critical data is valid or otherwise comprises an indication that the order critical data has been altered in the event that the order critical data is invalid ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

As to claim 42:

Hughes expressly teaches:

further comprising the step of the validation server transmitting the electronic order to at least one relevant merchant for fulfillment in the event that the order critical data is valid ([0063], Figure 4)

As to claim 43:

Hughes expressly teaches:

further comprising the step of the validation server rejecting the electronic order in the event that the order critical data is invalid ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 44 and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes and in view of Carpenter et al., (US 2004/0205003) ("Carpenter").

As to claims 44 and 49:

Hughes teaches substantially as claimed:

further comprising the validation server executing the steps of:

including information indicating whether or not said order critical data is valid ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7); and

to one or more relevant merchants receiving the electronic order thus enabling said merchants to identify if order critical data in the electronic order is valid ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

Hughes does not expressly teach:

generating a report;
transmitting the report;

However, Carpenter expressly teaches:

generating a report ([0025]-[0026], [0030], Claim 14);
transmitting the report ([0025]-[0026], [0030], Claim 14);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include the features of Carpenter because they both teach the related art of using a validation server to process transactions.

12. Claims 45 and 56 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes.

As to claim 45 and 56:

Hughes teaches substantially as claimed:

to the customer computer over the public data network ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7); and
generating the electronic order ([0005], [0049], [0062], [0079], Figures 1, 2A, 4-7);

Hughes does not expressly teach:

the customer downloading product details from the commerce server;
using the product details downloaded from the commerce server.

The Examiner takes Official Notice that the customer downloading product details from the commerce server and using the product details downloaded from the commerce server is old and well known, in the related art. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hughes with the commonly recognized practice of the customer downloading product details from the commerce server and using the product details downloaded from the commerce server because transmitting "product details" to customers is an efficient method of providing customer with information necessary to complete a purchase.⁶

13. Claims 46-47, 50-51, 53-54 and 57-58 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes and in view of Wasilewski, (US 2003/0018976) ("Wasilewski").

As to claims 46, 50, 53, 57:

Hughes discloses as discussed above; however, Hughes does not expressly disclose:

wherein said product details comprises the order critical data and wherein the order critical data is digitally signed with a secret key, and

⁶ Jang (US 2004/0059684); [0034] Referring to FIG. 4, an employee who desires to purchase a product from an Internet electronic commerce site, which is operated by the electronic commerce server 1 of a particular company, connects to the electronic commerce server 1 through the Internet 5 via a PC or mobile phone (3a or 3b) and logs into the electronic commerce server 1 by inputting the ID and password stored in the employee data base 23 (Step 401). The home page of the electronic commerce site operated by the electronic commerce server 1 is displayed on the employees' PC or mobile phone. The employee searches the electronic commerce site. The control module 20 of the electronic commerce server 1 extracts product information from the product data base 21 and transmits the information via the communication module 24, so that the product information is displayed (Step 402). When the employee decides to purchase a product, the information on the chosen product is provided to the control module 20 of the electronic commerce server 1 via the communication module 24 of the electronic commerce server 1 (Step 403).

wherein:

the step of transmitting comprises transmitting the digital signature along with the electronic order; and

the step of verifying comprises the validation server verifying that the digital signature corresponds with the order critical data.

However, Wasilewski expressly teaches:

wherein said product details comprises the order critical data and wherein the order critical data is digitally signed with a secret key ([0028]-[0029], [0030], [0032], [0035]); and wherein:

the step of transmitting comprises transmitting the digital signature along with the electronic order ([0002], [0013], [0031]-[0032], [0035]-[0036], Claims 10, 17, 28 30); and

the step of verifying comprises the validation server verifying that the digital signature corresponds with the order critical data ([0013], [0032], [0035]-[0036]);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include the features of Wasilewski because they are both in the related art of processing ecommerce transactions.

As to claims 47, 51, 54, 58:

Hughes discloses as discussed above; however, Hughes does not expressly disclose:

wherein the order critical data is duplicated in said product details, which comprise a first copy of the order critical data in unencrypted form and a second copy encrypted using a secret key, and wherein:

the step of transmitting includes transmitting the encrypted copy of the order critical data along with the electronic order; and

the step of verifying includes the validation server verifying that the encrypted data corresponds with the unencrypted order critical data in the electronic order.

The Examiner takes Official Notice that wherein the order critical data is duplicated in said product details, which comprise a first copy of the order critical data in unencrypted form and a second copy encrypted is old and well known. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Hughes with the commonly recognized practice of wherein the order critical data is duplicated in said product details, which comprise a first copy of the order critical data in unencrypted form and a second copy encrypted is old and well known because sending "duplicate" requests aids in ensuring that the requests are received to be processed.⁷

However, Wasilewski expressly teaches:

the step of transmitting includes transmitting the encrypted copy of the order critical data along with the electronic order ([0002], [0013], [0031]-[0032], [0035]-[0036], Claims 10, 17, 28 30); and

the step of verifying includes the validation server verifying that the encrypted data corresponds with the unencrypted order critical data in the electronic order

⁷ Brendel (US 6,772,333); A load-balancer assigns incoming requests to servers at a server farm. An atomic operation assigns both un-encrypted clear-text requests and encrypted requests from a client to the same server at the server farm. An encrypted session is started early by the atomic operation, before encryption is required. The atomic operation is initiated by a special, automatically loaded component on a web page. This component is referenced by code requiring that an encrypted session be used to retrieve the component. Keys and certificates are exchanged between a server and the client to establish the encrypted session. The server generates a secure-sockets-layer (SSL) session ID for the encrypted session. The server also generates a server-assignment cookie that identifies the server at the server farm. The server-assignment cookie is encrypted and sent to the client along with the SSL session ID. The Client decrypts the server-assignment cookie and stores it along with the SSL session ID. The load-balancer stores the SSL session ID along with a server assignment that identifies the server that generated the SSL session ID. When other encrypted requests are generated by the client to the server farm, they include the SSL session ID. The load-balancer uses the SSL session ID to send the requests to the assigned server. When the client sends a non -encrypted clear-text request to the server farm, it includes the decrypted server-assignment cookie. The load balancer parses the clear-text request to find the server-assignment cookie. The load-balancer then sends the request to the assigned server.

([0002], [0013], [0031]-[0032], [0035]-[0036], Claims 10, 17, 28 30);

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hughes to include the features of Wasilewski because they are both in the related art of processing ecommerce transactions.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Jang (US 2004/0059684); [0034] Referring to FIG. 4, an employee who desires to purchase a product from an Internet electronic commerce site, which is operated by the electronic commerce server 1 of a particular company, connects to the electronic commerce server 1 through the Internet 5 via a PC or mobile phone (3a or 3b) and logs into the electronic commerce server 1 by inputting the ID and password stored in the employee data base 23 (Step 401). The home page of the electronic commerce site operated by the electronic commerce server 1 is displayed on the employees' PC or mobile phone. The employee searches the electronic commerce site. The control module 20 of the electronic commerce server 1 extracts product information from the product data base 21 and transmits the information via the communication module 24, so that the product information is displayed (Step 402). When the employee decides to purchase a product, the information on the chosen product is provided to the control module 20 of the electronic commerce server 1 via the communication module 24 of the electronic commerce server 1 (Step 403).

Brendel (US 6,772,333); A load-balancer assigns incoming requests to servers at a server farm. An atomic operation assigns both un-encrypted clear-text requests and encrypted requests from a client to the same server at the server farm. An encrypted session is started early by the atomic operation, before encryption is required. The atomic operation is initiated by a special, automatically loaded component on a web page. This component is referenced by code requiring that an encrypted session be used to retrieve the component. Keys and certificates are exchanged between a server and the client to establish the encrypted session. The server generates a secure-sockets-layer (SSL) session ID for the encrypted session. The server also generates a server-assignment cookie that identifies the server at the server farm. The server-assignment cookie is encrypted and sent to the client along with the SSL session ID. The Client decrypts the server-assignment cookie and stores it along with the SSL session ID. The load-balancer stores the SSL session ID along with a server assignment that identifies the server that generated the SSL session ID. When other encrypted requests are generated by the client to the server farm, they include the SSL session ID. The load-balancer uses the SSL session ID to send the requests to the assigned server. When the client sends a non-encrypted clear-text request to the server farm, it includes the decrypted server-assignment cookie. The load balancer parses the clear-text request to find the server-assignment cookie. The load-balancer then sends the request to the assigned server.

Any inquiry concerning this communication or earlier communication from

the examiner should be directed to Mr. Dante Ravetti whose telephone number is (571) 270-3609. The examiner can normally be reached on Monday – Thursday 9:00am-5:00pm.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Calvin Hewitt may be reached at (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is (571) 270-4609.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, please contact the Electronic Business Center (EBC) at 1-(866) 217-9197. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 1-(800) 786-9199 (IN USA or CANADA) or 1-(571) 272-1000.

/Dante Ravetti/
Examiner, Art Unit 3685
Wednesday, August 04, 2010

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
August 7, 2010

